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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,001	09/17/2001	Ulf Schroder	SCHR3003/REF	6616

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EXAMINER
FORD, VANESSA L

ART UNIT	PAPER NUMBER
1645	

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/926,001	SCHRODER ET AL.	
	Examiner	Art Unit	
	Vanessa L. Ford	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-10 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No.09/926,002. Application No. 09/926,001 and 09/926,002 both teach antigens and adjuvants (i.e. monoglycerides comprising mono-olein and oleic acid). Application No. 09/926,001 does not disclose immunogenically active carriers (IACs) that are covalently bonded to the antigens. Application No. 09/926,002 discloses an antigen coupled to an immunogenically active carrier and adjuvant (i.e. monoglycerides comprising mono-olein and oleic acid). Svenson, *(WO 97/35616, published October 1997),* teaches the combination of antigen conjugated to immunogenically active carriers. It would be obvious to prepare a vaccine with an antigen and adjuvant as set forth in Application No. 09/926,001 and to combine the same antigen with the immunogenically active carrier as taught in Application No.

09/926,002 as set forth by Svenson. The disclosure of Svenson renders Application No. 09/926,001 overlapping with the invention set forth in Application No. 09/926,002 such that the claims in each are properly rejected under the judicially created doctrine of obviousness-type double patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claim 1 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation "may contain". It is unclear as to if the acyl chain of the claimed invention contains one or more unsaturated bonds"? Does the acyl chain contain unsaturated bonds? The metes and bonds of the claimed invention cannot be ascertained. Clarification is required.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claim 3 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation "optionally". It is unclear as to how any unsaturated bonds are contained in the claimed

invention. The metes and bonds of the claimed invention cannot be ascertained. Clarification is required.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claim 4 (line 3) recite "and" which renders the claim indefinite by reciting improper Markush language. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.d. 126 (Comm'r Pat. 1925). It is unclear to which combinations of chemicals the claim is referring?

5. Claim 5 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation "possibly soybean oil". It is unclear as to if the soybean oil is used in the vaccine formulation? If soybean is used in the claimed invention, what percentage of soybean oil maybe used in the claimed invention? Clarification is required.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Youmans et al *(Journal of Bacteriology, January 1969, p. 107-113)* in view of Schroder *(WO 97/47320, published December 1997).*

Claims 1-9 are drawn to a tuberculosis vaccine composition comprising as adjuvant one or more substances selected from monoglyceride preparations having 80% monoglyceride content.

Youmans et al teach a tuberculosis vaccine comprising killed *Mycobacterium tuberculosis* which were killed by heat or chemicals (page 108). Youmans et al teach that the *Mycobacterium tuberculosis* were contained in phosphate buffer solution (page 109). Youmans et al teach that mice were administered the killed vaccine both with and without an adjuvant (pages 111-112).

Youmans et al do not teach adjuvants that comprise monoglycerides.

Schroder teaches the use of monoglycerides as adjuvants. Schroder teaches that the parenteral or mucosal administration of a pharmaceutical formulation containing monoglycerides (i.e. mono-olein/oleic acid) improves the immune response against admixed antigens/vaccines (page 4, lines 16-25). Schroder teaches that a combination between a monoglyceride and a fatty acid can stimulate the immune system to produce antibodies and induce protective immunity (page 7, lines 6-9). Limitations such as "mucosal administration is being view as a limitation of intended use. However, it is well known in the art that lipid preparations that are used as adjuvants are not restricted to one mode of administration and can be used in many routes of administration including mucosal. Limitations such as packaging the vaccine as an aersol, spray or nose-drop package is being viewed as a limitation of design choice.

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to add the monoglyceride preparation as taught by

Schroder to the *Mycobacterium tuberculosis* of Youmans et al because Schroder teaches that a combination between a monoglyceride and a fatty acid can stimulate the immune system to produce antibodies and induce protective immunity (page 7, lines 6-9). It would have been expected barring evidence to the contrary, that the addition of monoglycerides to *Mycobacterium tuberculosis* vaccines would provide enhancement of immunological responses after administration of monoglycerides and/or fatty acids together with antigens and the use of monoglycerides in vaccines are stable, cheaper and easy to formulate.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Youmans et al *(Journal of Bacteriology, January 1969, p. 107-113)* in view of Schroder *(WO 97/47320, published December 1997).*

Claim 10 is drawn to a method of vaccinating a mammal against Tuberculosis which comprises mucosal administration to the mammal of an protection-inducing amount of a tuberculosis vaccine composition.

Youmans et al teach a method of vaccinating mice comprising administering killed *Mycobacterium tuberculosis* with and without Freund's adjuvant (pages 111-112). Youmans et al teach that administration of the tuberculosis vaccine did indeed provoke immune response (page 110).

Youmans et al do no teach the use of monoglycerides as adjuvants.

Schroder teaches a method of vaccinating mice comprising a diphtheria antigen and a monoglyceride preparation (page 9, example 4). Schroder teaches that both IgG

as well as protective antibody titers were at the same level as compared to the control groups which received a composition of diptheria toxoid and alum. Schroder also teaches that the high IgG titers always were accompanied by high neutralization titers indicating that the formulations do no destroy the antigenic sites that are important for protective immunity (page 9, Example 4).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to add the to monoglyceride preparation of Schroder to the *Mycobacterium tuberculosis* vaccine composition used in the method of vaccinating a mammal as taught by Youmans et al because Schroder teaches that the parenteral or mucosal administration of a pharmaceutical formulation containing monoglycerides (i.e. mono-olein/oleic acid) improves the immune response against admixed antigens/vaccines (page 4, lines 16-25). It would have been expected barring evidence to the contrary, that the addition of monoglycerides to *Mycobacterium tuberculosis* vaccines would provide enhanced immunogenicity of antigens and that formulations are stable, inexpensive and easy to formulate.

Pertinent Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure *(Landh, WO 93/06921, published April 1993 and Gizurarson, WO 94/17827, published August 1994).*

Status of Claims

9. No claims are allowed.

Conclusion

10. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308–0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 308-4242.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (703) 308-4735. The examiner can normally be reached on Monday – Friday from 7:30 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308–3909.

Vanessa L. Ford
Biotechnology Patent Examiner
February 5, 2002

JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600